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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re M & N Plastics, Inc.

Serial No. 76182175

Thomas N. Young of Young & Basile, P.C. for M & N Plastics, Inc.

Brian J. Pino, Trademark Examining Attorney, Law Office 114
(Margaret Le, Managing Attorney).

Before Walters, Chapman and Rogers, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On December 8, 2000, M & N Plastics, Inc. (a Florida corporation) filed an application to register the mark JOE COOL on the Principal Register for "plastic sleeves providing thermal protection to users of hot drink cups" in International Class 21. The application was based on applicant's assertion of a bona fide intention to use the mark in commerce. The mark was published for opposition on

September 11, 2001; and a Notice of Allowance issued on December 4, 2001. Applicant filed a Statement of Use on May 28, 2002, along with one specimen, alleging a date of first use and first use in commerce of November 1, 2001. The specimen is a photograph of a clear plastic sleeve for hot drink cups, showing JOE COOL in large lettering on two sides in the center of the sleeve, and 800 4 JOE COOL in small lettering near the top of one side only. These words and numbers are embossed into the clear plastic.

The Examining Attorney refused registration under Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127 of the Trademark Act, on the ground that the proposed mark is merely ornamental and does not function as a mark as used on the goods.

When the refusal was made final, applicant appealed. Briefs have been filed. Applicant did not request an oral hearing.

It is the Examining Attorney's position that the overall commercial impression of applicant's proposed mark is not that of a trademark, because (i) it invokes the popular, well known phrase JOE COOL used for a variety of goods and services (e.g., The "Peanuts" cartoon strip character "Snoopy's" alternate persona--JOE COOL), and (ii) the size, location and dominance of the wording appears on

the goods in large letters and in a decorative manner. In support of the Examining Attorney's contention that the wording JOE COOL does not indicate source, but rather is merely ornamental, he submitted printouts of ten pages from a "Google" search for "JOE COOL" (24,200 hits), contending that this shows use of these words for a wide variety of goods and services.

The Examining Attorney specifically argues, citing the case of *In re Tilcon Warren, Inc.*, 221 USPQ 86, 88 (TTAB 1984) (WATCH THAT CHILD, for crushed stone and other aggregates and asphaltic and ready-made concrete, used on the bumper of trucks transporting applicant's goods, held not to function as a trademark), that whether a proposed mark functions as a mark is a question of fact on which the judgment of the Examining Attorney is entitled to a presumption of correctness; and that the burden of proof is on applicant to establish that the purportedly ornamental matter does function as a mark. He then notes that applicant did not submit any evidence that (i) the nature and placement of the wording JOE COOL on the goods is unique or unusual in the practice of the trade, (ii) the wording is recognized as indicating a secondary source (i.e., sponsorship or association rather than the manufacturing source), and/or (iii) the mark has acquired

distinctiveness as a source indicator.¹ The Examining Attorney concludes that the wording JOE COOL is not inherently distinctive as it is a common phrase; and that as used on the goods, consumers will perceive the mark as merely an ornamental feature of the goods.

According to the Examining Attorney, in the absence of evidence that the words JOE COOL have acquired distinctiveness as a source indicator or a showing that the words indicate a secondary source or sponsorship of the goods, the mark is not registrable. The Examining Attorney relies on cases such as *In re Pro-Line Corp.*, 28 USPQ2d 1141 (TTAB 1993)(BLACKER THE COLLEGE SWEETER THE KNOWLEDGE for t-shirts, sweatshirts and shirts held mere ornamentation); *In re Dimitri's Inc.*, 9 USPQ2d 1666 (TTAB 1988)(SUMO for t-shirts and baseball-style hats held mere ornamentation); *In re Astro-Gods Inc.*, 223 USPQ 621 (TTAB 1984)(ASTRO GODS and design for t-shirts held mere ornamentation); and *In re Original Red Plate Co.*, 223 USPQ 836 (TTAB 1984)(YOU ARE SPECIAL TODAY for ceramic plates held mere ornamentation).

¹ Regarding these three factors, the Examining Attorney specifically states that the first two factors cannot be considered because applicant provided no evidence thereon, and the third such factor is moot because of the lack of evidence thereon.

Applicant contends that its mark JOE COOL for plastic sleeves providing thermal protection to users of hot drink cups is inherently distinctive; that the mark JOE COOL is unique as to plastic thermal sleeves for hot drink cups; that the placement of the mark on applicant's goods is in a manner that allows the designs/marks of the sleeve purchaser to remain visible on drink cups when the sleeve is used on cups in the marketplace; that applicant's evidence, in the form of two promotional advertisements, shows that its goods provide exceptional insulation, are environmentally friendly and allow the sleeve purchaser's trademarks/graphics to be seen by beverage consumers; and that applicant's mark is used on the specimen as a trademark and it is advertised and promoted as a trademark and therefore JOE COOL would be perceived by sleeve purchasers as the source indicator.

Preliminarily, we note that applicant submitted four exhibits with its reply brief. They are (i) photocopies of applicant's two promotional advertisements; (ii) printouts of a few registrations consisting of or including the words "JOE COOL" from the USPTO's Trademark Electronic Search System (TESS); (iii) two photographs showing "COKE" or "COCA COLA" on cans of soda; and (iv) two paper sleeves for

hot drink cups showing "STARBUCKS" and "EINSTEIN BROS.," respectively thereon.

The photocopies of applicant's advertisements were already of record, and have been considered. However, the other three exhibits were submitted for the first time with applicant's reply brief. The record in an application should be complete prior to the filing of an appeal, and additional evidence filed after appeal will be given no consideration by the Board. See Trademark Rule 2.142(d), and TBMP §1207.01 (2d ed. June 2003). These three exhibits, attached to applicant's reply brief, were untimely pursuant to Trademark Rule 2.142(d), and, accordingly, have not been considered.

We agree with the Examining Attorney that the question of mere ornamentation is a question of fact, but we disagree with the Examining Attorney that his opinion is to be presumed correct, thereby shifting the burden of proof to the applicant to show that the proposed mark is not mere ornamentation. The Tilcon Warren case, cited by the Examining Attorney as the authority for the purported presumption, did not involve a refusal based on use of the mark as mere ornamentation. Rather, the slogan involved in that case was refused registration solely on the basis that it did not function as a trademark for the involved goods.

The test when determining whether a mark is mere ornamentation, or ornamentation that also functions as an indicator of source, involves consideration of factors such as the size, location, dominance and significance of the alleged mark as applied to the goods. See In re Pro-Line, supra, and cases cited therein. See also, TMEP §1202.03 (3d ed. 2002).

As the Board stated in the case of In re Paramount Pictures Corp., 213 USPQ 1111, 1115 (TTAB 1982)(MORK & MINDY for decals held not mere ornamentation):

Clearly, there is no prescribed method or place for affixation of a mark to goods. In every case, the question is not whether the mark has been associated with the goods by a particular mode or manner, but whether the matter sought to be registered performs the function of a trademark by signifying to purchasers the source of the goods sold or offered for sale.

The Examining Attorney essentially required "small, neat, and discrete" wording that applicant could have placed "around the rim or lip of the goods." We disagree that such specific usage is required to create a commercial impression of use as a trademark. In any event, applicant does display the words "JOE COOL" in small lettering near the top of the sleeve, as part of the telephone number (appearing once on the sleeve), as well as in large

lettering in the center of the plastic sleeve (appearing twice on the round sleeve). Thus, even if the Examining Attorney were correct in arguing that the larger display constituted ornamentation, the smaller, more discrete display would, by the Examining Attorney's own analysis, function as a mark.

With regard to the meaning of the phrase, the fact that "JOE COOL" appears over 24,000 times in a "Google" search of the Internet does not establish that it is not inherently distinctive when used on the involved goods. The Examining Attorney submitted ten pages of listings of these 24,000+ "Google" hits, but there is no context provided for any of the listed stories or hits. Applicant argued in its reply brief that while "JOE BLOW," "JOE COLLEGE" and "JOE DOAKES" appear in a dictionary, "JOE COOL" does not. Applicant did not provide a copy of the dictionary page. However, we take judicial notice [see TBMP §704.12(a) (2d ed. June 2003)] of The Random House Dictionary (Second Edition 1987) showing the same information--listings of "JOE BLOW," "JOE COLLEGE" and "JOE DOAKES," but no listing of "JOE COOL."

Applicant's use of JOE COOL as applied to plastic sleeves to provide thermal protection in the use of hot drink cups appears to be arbitrary usage, rather than being

perceived as a common cultural expression such as the "smiley face" symbol, or the peace symbol, or the phrase HAVE A NICE DAY.

Moreover, in this case, there is further specific evidence of applicant's use of JOE COOL as a trademark for its goods as shown in applicant's two advertisements (excerpts of which are set forth below):

IT GOES UNNOTICED SO YOU DON'T
JOE COOL™ IS INVISIBLE

...
Joe Cool insulated sleeves are clear,
so your image is on display, not the
sleeve. Graphics you've created can
even be embossed on the sleeve to
enhance that image; and

Don't look now, here comes Joe Cool.
There's something to be said for going
unnoticed.

Thus, the retailers who purchase applicant's goods clearly would understand JOE COOL is a trademark for plastic sleeves for thermal protection, indicating applicant as the source thereof. Such purchasers will not be motivated to purchase applicant's goods because of the presence of the wording JOE COOL embossed thereon. Rather, they will be motivated to purchase the goods because beverage purchasers will not be distracted by applicant's mark and can be exposed to whatever message the beverage producer wants to put on its cups.

We find that the phrase JOE COOL, as used by applicant, is inherently distinctive and is likely to be perceived by the relevant purchasers as an indicator of source. Cf. In re Watkins Glen International, Inc., 227 USPQ 727 (TTAB 1985)(a checkered flag design for various items of clothing and patches for application to clothing held to be not only an ornamental design but also an indication of origin of the goods).

Decision: The refusal to register under Sections 1, 2 and 45 of the Trademark Act as mere ornamentation is reversed.